

REMARKS

Heading I

Claims 33 – 40 and 42 – 46 and 56 are rejected under 35 U.S.C. 103(a) being unpatentable over Smith in view of Beck, the following background applies for all subheadings herein.

Under the M.P.E.P standards, any alleged motivation to combine or modify must be objectively verifiable. The M.P.E.P recognizes the pitfalls associated with the tendency to subconsciously use impermissible “hindsight” when an examiner attempts to establish such a rationale. The M.P.E.P has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that “under 35 U.S.C. § 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. M.P.E.P. § 2142.

Applicants respectfully point out that nowhere has the Office Action pointed to any objectively verifiable motivation to modify and/or combine the teachings of the art of record to produce the claimed invention beyond the following bare assertions.

Subheading I - A: Independent Claim 33

Smith teaches presentation of surveys to survey takers (known as “network user clients” in Smith) through web page banners that contain hypertext links to surveys. By selecting a banner, a network user client is automatically provided with a corresponding survey. Paragraph [0058] Smith provides access to surveys through web page banners either by statically mapping or dynamically mapping between web site locations for the web page banners and groups of potential survey takers. Static mappings are relatively fixed between web site locations for web page banners and types of survey takers. For instance, a static mapping may exist between a target

group of kids and a specific portion of a Yahoo site or other kid related web site locations. Paragraph [0119]

A dynamic mapping delivers to a network user a web page that is a banner for a survey and is not particularly dependent upon a certain web site location. The survey is chosen for the network user based upon acquiring data that identifies the network user, locating within an information repository or database prior to information that was obtained about the network user, and determining a target group to which the network user belongs based upon the information in the repository. Paragraph [0120] It should be remembered that regardless of whether static mapping or dynamic mapping is used, the survey takers access their surveys through hyperlinks found in banners on web pages of predetermined web sites.

The banners are either statically or dynamically created, but nevertheless, in Smith, the banners are always used by the survey takers to access their surveys. In other words, for static banners, it is assumed that survey takers of a particular type will naturally gravitate toward certain web sites so that particular static banners are placed on web pages of these web sites in anticipation that these survey takers will eventually visit the web site. Paragraph [0119] For dynamic banners, it is assumed that potential survey takers will visit certain web sites either on their own or through solicitation and once at the web site it can be determined which particular banner to present to the potential survey taker in order that the potential survey taker can access an appropriate survey. Paragraph [0120]

When a survey is fielded to a particular target group, the results are gathered, processed, and analyzed to generate survey data that reflects the survey results. In Smith, the survey data can then be sent by e-mail to the survey creator. It must be emphasized that although Smith mentions that the survey data from processed survey results can be sent by e-mail to the survey creator, this is much different than using e-mail to send an access to the actual survey itself as discussed further below for the presently claimed invention. In Smith, obtained to the survey itself is not sent to a

survey taker through an e-mail but is rather accessed by the survey taker through a hyperlink located on a banner of a web page found on a web site. Paragraph [0110]

Beck teaches new client survey taking via e-mail because the new clients do not have access to an enterprise web page. Paragraph [0118] Beck also teaches an e-mail module that pushes pre-scripted e-mails to clients containing instructions or other resolute material associated with a purchase product or service. Paragraph [0387] This teaching of e-mail use in Beck does not make sense to combine with Smith as a secondary reference. In Smith, the survey takers most assuredly have access to web pages to use banners on the web pages to access surveys.

In Beck, survey takers most assuredly do not have access to web pages, which is the whole point of using e-mail for surveys in Beck and is just the opposite condition from Smith. Furthermore, Smith's model for survey access through web page banners has no use for Beck's access. The teaching in Beck is unnecessary and irrelevant to Smith. The other reference to e-mail in Beck has nothing to do with taking surveys so there is also no reason to consider combining this with Smith.

In summary, Smith and/or Beck alone or in combination do not teach or suggest claim 33 regarding a survey creation engine configured to create surveys, a survey design machine configured to communicate with the survey creation engine . . . to create a survey . . . and an e-mail list management facility configured to provide management capability through the network browser of the survey design machine of a list of e-mail recipients chosen to receive an e-mail . . . containing a network link to provide access to the survey for the client computer. Yet, the Office Action puts forth a bare assertion that Smith in combination with Beck teaches such.

In addition, the Office Action's suggestion to combine Smith in view of Beck is not found either explicitly and/or implicitly in Smith and/or Beck. Furthermore, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of Smith in view of Beck.

Consequently, the suggestion offered by the Office Action to combine Smith in view of Beck is purely a bare assertion since the explanation offered by the Office Action as to the reasonableness of the suggestion to combine is given without any attestation by signed affidavit as to the fact that the suggestion and explanation came from a properly qualified expert.

Given the use of bare assertion without substantive support for supporting argumentation in the rejection of claim 33, the Office Action has failed to support a *prima facia* case of obviousness for claim 33. Consequently, it is believed that claim 33 stands in condition for allowance.

Subheading I - B. Independent Claim 47

Claim 47 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claim 33." Since the arguments by the Office Action in rejecting claim 33 used bare assertion involving inaccurate representation of the content of Smith and Beck and an unattested opinion regarding a proposed suggestion to combine Smith and Beck as discussed above, the arguments of the Office Action regarding claim 33 have similarly failed to support a *prima facia* case of obviousness to reject claim 47.

Furthermore, in rejecting claim 47, the Office Action inaccurately represents paragraphs [0033] – [0035] of Desai by stating that these paragraphs teach a portion of claim 47 regarding using a survey design computer via the network to edit a list of e-mail recipients stored on the host computer wherein some of the recipients are to be sent an e-mail containing a network link to access a survey. Contrary to this inaccurate statement by the Office Action, paragraphs [0033] – [0035] only teach forwarding a questionnaire to a client. Furthermore, the Applicant could not find anywhere in Desai the teaching of the portion of claim 33 as stated to exist by the Office Action. Consequently, the Office Action's use of Desai in an attempt to supply teaching for the portion of claim 33 is merely a bare assertion that such a teaching exists in Desai.

Furthermore, the Office Action's suggestion to combine Smith in view of Beck and further in view of Desai is not found either explicitly and/or implicitly in Smith and/or Beck and/or Desai. In addition, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of Smith in view of Beck, further in view of Desai. Consequently, the suggestion offered by the Office Action to combine Smith in view of Beck, further in view of Desai with regard to the claim 47 rejection is purely a bare assertion on these additional grounds as well as those above since the explanation offered by the Office Action as to the reasonableness of the suggestion to combine is given without any attestation by signed affidavit as to the fact that the suggestion and explanation came from a properly qualified expert.

Given the use of bare assertion for supporting argumentation in the rejection of claim 47, the Office Action has failed to support a prima facia case of obviousness for claim 47. Consequently, it is believed that claim 47 stands in condition for allowance.

Subheading I - C. Independent Claims 52, 53, and 54.

Claims 52, 53, and 54 were rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and are similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck, and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith, Beck, and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facia case of obviousness to reject claims 52, 53, and 54.

Subheading I - D. Independent Claim 55.

Claim 55 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is]

similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck and Desai and an unattested opinion regarding a proposed suggestion to combine Smith, Beck and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a *prima facia* case of obviousness to reject claim 55.

Furthermore, claim 55 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to resize web content objects to be added during survey creation. The Applicants could not find anywhere in Smith and/or Beck and/or Desai where this was suggested or taught, so claim 55 is believed to be allowable for this additional reason.

Subheading I - E. Independent Claim 57.

Claim 57 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck, and Desai and an unattested opinion regarding a proposed suggestion to combine Smith, Beck and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a *prima facia* case of obviousness to reject claim 57.

Furthermore, claim 57 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select progress bars to be added by the survey creation engine. The Applicants do not believe the mere processing of results is similar to selecting progress bars and could not find anywhere in Smith and/or Beck and/or Desai where this was suggested or taught, so claim 57 is believed to be allowable for this additional reason.

Subheading I - F. Independent Claim 58.

Claim 58 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck, and Desai and an unattested opinion regarding a proposed suggestion to combine Smith, Beck, and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a *prima facia* case of obviousness to reject claim 58.

Furthermore, claim 58 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to perform survey background design. The Applicants could not find anywhere in Smith and/or Beck and/or Desai where this was suggested or taught, so claim 58 is believed to be allowable for this additional reason.

Subheading I - G. Independent Claim 59.

Claim 59 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith, Beck and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a *prima facia* case of obviousness to reject claim 59.

Furthermore, claim 59 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select font of text used of a survey created by the survey creation engine. The Applicants could not find anywhere in Smith, including Figure 3 – sheet 4 of 11, and/or

Beck and/or Desai where this was suggested or taught, so claim 59 is believed to be allowable for this additional reason.

Subheading I - H. Independent Claim 60.

Claim 60 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith, Beck, and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith, Beck, and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a *prima facia* case of obviousness to reject claim 60.

Furthermore, claim 60 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select color scheme of a survey created by the survey creation engine. The Applicants could not find anywhere in Smith and/or Beck and/or Desai where this was suggested or taught, so claim 60 is believed to be allowable for this additional reason.

Conclusion of Heading

As discussed above, the art of record, namely, the first combination of Smith in view of Beck and the second combination of Smith in view of Beck and further in view of Desai, does not contain sufficient teaching to render obvious to one of ordinary skill in the art at the time of the invention the pending independent claims, namely, claims 33, 47, 52 – 55, and 57 - 60 and consequently, does not render the dependent claims 34 – 46, 48 – 51, and 56 obvious either.

Consequently, it is believed that the Applicants' patent application has been used as a template to piece references together in an attempt to reject the pending claims and that this attempt fails because these references do not lend themselves to be combined or modified with each other to read on the claimed invention. In addition these references have been misread, such as Smith allegedly containing an e-mail list

management facility configured to provide management capability through the network browser of the survey design machine of a list of e-mail recipients chosen to receive an e-mail associate with a survey, the list being stored on the host machine, the e-mail containing a link to provide access to the survey for the client computer, to force them to read on the claimed invention.

Accordingly, insofar as that the only objectively verifiable teachings of record showing the alleged motivation to modify and/or combine reside in Applicants' patent application, it follows that the Office Action has used Applicants' patent application as a template by which to piece together the related art to reach Applicants' claims at issue. As set forth above, under the M.P.E.P. standards this is impermissible hindsight. Accordingly, Applicants respectfully request that Examiner allow the pending claims for at least this reason.

As discussed above, all the pending independent claims (claims 33, 47, 52 – 55, and 57 – 60) are believed to be allowable. The pending dependent claims (claims 34 – 46, 48 – 51, and 56) are also believed to be allowable, based at least in part upon their dependencies.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully request a Notice of Allowance relating to all pending claims, all having been previously allowed.

If additional fees are believed necessary, the Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 04-0258.

The Examiner is encouraged to phone applicants' attorney, Brian L. Johnson at (206) 628-7670, to resolve any outstanding issues and expedite issuance of a final Notice of Allowance.

Entry of the Amendment is respectfully requested.

Respectfully submitted,
Chris Greener et al.
DAVIS WRIGHT TREMAINE LLP

By 

Brian L. Johnson
Registration No. 40,033

Enclosure:
Postcard

2600 Century Square
1501 Fourth Avenue
Seattle, WA 98101-1688
Phone: (206) 628-7670
Facsimile: (206) 903-3770